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- **102(b) date of pub: refereed IEEE paper**
Papers presented to the IEEE's ISSCC Program Committee for consideration of publication in the Digest distributed at the next IEEE ISSC Conference are considered publications only as of the date of the Conference. They were not made available to the public as contemplated by 35 USC 102(b) when sent to the peer review committee. *National Semiconductor Corp. v. Linear Technology Corp.* 8 USPQ2d 1359 (DC ND CA 1988).
- **112 2d para indef can't rej. as obv.**
Claims invalid for being vague and indefinite under 35 USC 112, second paragraph. A recumbent bicycle claim. Claims invalid for indefiniteness cannot also be invalid for obviousness since a finding of obviousness would require reliance on speculative assumptions as to meaning of claims. *Ex parte Brummer*, 12 USPQ2d 1654 (BPAI 1989).
- **2 different experimental use exceptions**
The experimental use exception to a public use or sale protects an invention for the period of development and testing prior to patent application. The experimental use exception to infringing uses narrows the scope of intellectual property protection, protecting unauthorized use of a patent during tests to advance or commercialize the patented teaching. *Deuterium Corp. v. U.S.*, 14 USPQ2d 1636 (Cl. CT. 1990).
- **35 USC 101 - Data Structures - method claim**
Claimed "data structure" as used in METHOD of controlling motion of objects and machines DOES NOT constitute patentable subject matter under 35 USC 101. That term refers to the ideas reflected in the process of making a bubble hierarchy - and is nothing more than another way of describing the manipulation of ideas. *In re Warmerdam*, 31 USPQ 1754, 1760 (CAFC 1994).
- **35 USC 101 problem: essentially algorithm**
CAFC affirms holding that claims are directed to nonstatutory subject matter under 35 USC 101. Claims directed to a test method. Although mere recital of an algorithm does not automatically render a claim nonstatutory, it can do so if the claim in essence covers only the algorithm. *In re Grams*, 12 USPQ2d 1824 (Fed. Cir. 1989).
- **35 USC 101- good summary of prohibitions**
35 USC 101 excludes from the patent system such things as scientific theories, pure mathematics, laws of nature, immoral inventions such as (until 1977) gambling machines, or devices deemed to be scientifically impossible, e.g., perpetual motion machines, or inventions that are frivolous, mischievous, or injurious to the well-being, good policy or good morals of society. *Tolomatic v. Proton Prod.* 20 USPQ2d 1332 (CAFC 1991).
- **35 USC 101: improper business method claims.**
Appellant's claimed accounting METHOD is not proper subject matter for patent protection either because it is a method of doing business and/or it preempts an algorithm. *The Payne Weber v. Merrill Lynch* case was distinguished because it claimed a system and contained no method claims. *Ex parte Murray*, 9 USPQ2d 1819 (BPAI 1988).
- **35 USC 101: living organisms may be OK**
Commissioner's Notice at 1077 Official Gazette (OG) 24 (April 21, 1987) stated that, to the extent that claimed subject matter is directed to a non-human "nonnaturally occurring manufacture or composition of matter - a product of human ingenuity," will NOT be rejected under 35 USC 101 as non-statutory subject matter. Party lacked standing to challenge. *Animal Legal Defence Fund v. Quigg*, 18 USPQ2d 1677 (CAFC 1991).
- **35 USC 102(b) bar: inconsistent testimony**
An "on sale" bar under 35 USC 102(b) was found. RCA's proposal in response to an FAA RFP offered for sale a device that had been actually reduced to practice more than one year before a patent was applied for. Testimony of witness on whether reduced to practice existed was alarmingly inconsistent with prior testimony on this issue. *RCA v. Data General*, 8 USPQ2d 1305 (DC D DEL 1988).

- **35 USC 102(b) on sale here**
On-sale Bar found in this case. T&L Electrical Copr. v. Square D Co. 29 USPQ2d 1715 (DC SFlorida 1993)
- **35 USC 102(b): pub. access not demonst'd**
Exhibits distributed to at least 50 commercial and private individuals and companies involved in a gov't project. They were supposed to contain a restrictive notice on reproduction and use, and were in a library, access to which was restricted. Public access here is so uncertain to preclude their being deemed printed publications. Northern Telecom Inc. v. Datapoint Corp., 9 USPQ2d 1577 (DC ND TX 1988).
- **35 USC 102(c) ABD v. 35 USC 102(g) ABD**
A rejection under 35 USC 102(c) based on abandonment reversed. Examiner argued that applicant "effectively reduced to practice the claimed invention five years before he filed his application. There was no actual red. to practice, however, which is needed for 102(g) abandonment to occur. 102(c) abandonment requires intent. Delay in filing doesn't show intent to abandon under 102(c), Ex parte Dunne, 20 USPQ2d 1479 (BPAI 1991).
- **35 USC 102(d) - patented in for. country**
35 USC 102(d) bars issuance of patent to U.S. applicant who has received a Spanish patent containing claims directed to processes for making certain compounds even though U.S. claims are directed to compounds themselves since reference to "invention patented" in 35 USC 102(d) includes all disclosed aspects of invention, even if not claimed in the foreign patent. In re Kathawala, 28 USPQ2d 1785 (CAFC 1993).
- **35 USC 102(e) and (g) N/A here**
Lost count doctrine and estoppel do not apply to appellants because, although they lost one interference, they won another, and in the one they one, the subject matter of those counts corresponds to the claims on appeal. Rejections under 35 USC 102(e) and 102(g) are not applicable, either, because of derivation from appellant. Ex parte Rohrer 20 USPQ2d 1460 (BPAI 1991).
- **35 USC 102(e) prior art**
Inventive entity of ABCD is "another" within the meaning of 35 USC 102(e) viv-a-vis the inventive entity of the present application (A and B), and is available prior art under 35 USC 102 (e), 102(f) and 102(g) for purposes of 35 USC 103. Ex parte DesOrmeaux, 25 USPQ 2040 (BPAI 1992).
- **35 USC 103 rej: no hindsight here**
There is no doubt that the use of hindsight in making a rejection under 35 USC 103 is prohibited. However, we hold that the combination of references in this rejection of applicant's claims was proper and not motivated by the use of hindsight. In re Spooner, 17 USPQ2d 1731 (CAFC 1990).
- **35 USC 112 written descrip req. not met**
In general, claims in a mechanical case may cover more than the specific embodiments shown, if the prior art permits. This claim specifically recites two species (a cylinder head, and a piston) having a recessed channel. No such piston species is disclosed. The claims don't comply with the written description req. of 35 USC 112. Ex parte Ohshiro, 14 USPQ2d 1750 (BPAI 1990).
- **35 USC 112(6): infringement guidance**
That part of a claim contains means-plus function language does not make 35 USC 112, Sec. 6, applicable to the entirety of the claim. That section cuts back on the types of means which could literally satisfy the claims. However, it has no effect on the function specified - it does not extend the element to equivalent functions. Johnston v. IVAC Corp. 12 USPQ2d 1382 (Fed. Cir. 1989) (Infringement case)
- **35 USC 112, 2d - indef. bicycle claims**
Claims to a recumbent bicycle are vague and indefinite and do not accurately determine the boundaries of protection sought. No known standard of sizing a bicycle to a rider exists in industry. Riders of the same height may not be of the same weight or have the same weight

distribution, e.g. Claims recite rider height, & rider & bicycle weight. Ex parte Brummer, 12 USPQ2d 1654 (BPAI 1989).

- **35 USC 112, fourth paragraph req'mnt**

Claim 10 recites a data transmission station with details. Claim 11 recited "at least two of the data transmission stations of claim 10," plus other apparatus. Claim 11 held to comply with 35 USC 112, 4th para because it recites a further limitation of the subject matter of claim 10; making plural what was singular in claim 10. Two dissents.

Ex parte Moelands, 3 USPQ2d 1474 (BPAI 1987).

- **35 USC 112, Paragraph Six -Alappat**

BPAI erred by refusing to apply 35 USC 112, paragraph six, in determining whether claims constituted patentable subject matter pursuant to 35 USC 101. In re Alappat, 31 USPQ2d 1545 (CAFC 1994).

- **35 USC 112,1st par. - must reject**

During the prosecution of the parent application, the Examiner acts as a fact finder. If an Examiner determines that an amended claim recites elements without support in the parent disclosure, the proper basis of rejection is 35 USC 112, 1st para. Objection alone does not give rise to estoppel. Final rejection under 112 does. Waldemar v. Osteonics. 31 USPQ2D 1855 (CAFC 1994).

- **35 USC 112,1st, intended word understood**

Claims under rejection based on 35 USC 112, 1st para, recited "copper complexes of imines", whereas specification disclosed "copper complexes of amines". but Table VIII lists working examples of imines. reading the disclosure as a whole, it is clear that "amines" is error and "imines" was intended, as undershoot by worker of ordinary skill in art. Ex parte Sorenson, 3 USPQ2d 1462 (BPAI 1987).

- **35 USC 112,2d "thick but not too dense"**

Claim language alleged to violate 35 USC 112,2d because it is too vague and prolix held not to violate that statute. While it is "somewhat thick, it is no denser than language in other patents cited to the court" and a reasonably skilled worker could understand what is patented and what is not. Haworth Inc. v. Steelcase Inc. 8 USPQ2d 1001 (DC WD MI 1988).

- **35 USC 112,2nd: "optionally" OK here**

35 USC 112, 2d issues must be decided on a case-by-case basis. Expressions "such as" and "particularly" may make claims indefinite depending on whether or not they introduce exemplary or limiting detail. Use of "optionally" in this claim does not make it indefinite. It is akin to "up to" and "0 to . . ." Ex parte Cordova, 10 USPQ2d 1949 (BPAI 1989)

- **35 USC 119 benefit for priority purpose**

To be accorded benefit for priority purposes under 35 USC 119, the prior application need only disclose AN embodiment (species) within the subject matter of the generic count to serve as a constructive reduction to practice. Staehelin v. Secher, 24 USPQ2d 1513, 1520 (BPAI 1992).

- **35 USC 119 benefit - split counts**

Original count split into two with Chloro going to one count and iodo & bromo going to the other count. British benefit application under 35 USC 119 taught "halogen" and only example was of "chloro". Board improperly gave benefit re both counts to the British applic. It should only have been given benefit regarding the count that recited "chloro." Bigham v. Gotfredsen, 8 USPQ2d 1266 (CAFC 1988).

- **35 USC 119 benefit:1st filed & w'in 1 yr**

35 USC 119 priority application must comply with 35 USC 112, 1st the same as for 35 USC 120 benefit, and only if the application was the FIRST foreign app. filed and was filed within 12 months prior to the U.S. applic. filing date (note the exception in Paris Conv, Art. 4C.(4) which did not apply here). Ex parte Yamaguchi, 6 USPQ2d 1805 (BPAI 1987).

- **35 USC 119 incorp. 35 USC 112, para 1.**

A foreign priority application under 35 USC 119 must comply with the same disclosure

requirements of 35 USC 112, first paragraph, including the description req. as does a parent U.S. application under 35 USC 120. The foreign application must also meet the same requirements of section 112 if the act of filing is considered as a reduction to practice of the applic. Ex parte Kitamura, 9 USPQ2d 1787(BPAI 1988)

- **35USC102(b) stat. bar: criteria**

A printed publication is one that is sufficiently accessible to members of the public who are interested in the art and exercise reasonable diligence. Here, the NSF grant proposal was indexed by title, author, institution and grant No. in the NSF's published indices of grants and awards starting in 1973, well before applicant's filing date, and meets these criteria - it is a 102(b) bar. Dupont v. Cetus, 19 USPQ2d 1174(DC,NDCAL 1990).

- **37 CFR 1,131 affidavit requirements**

This case sets forth the requirements of a Rule 131 affidavit, focusing on the fact that it must be "very fact based and detailed" and must show specific features with proof of the most convincing character. Any diligence must be shown from the date of the reference to an actual or constructive reduction to practice. Greenwood v. Seiko Instruments & Electronics, 13 USPQ2d 1245 (DC DC 1989).

- **37 CFR 1.109: Ct can give wt to Exr's Opn**

Claim interpretation by examiner set forth under 37 CFR 1,109 (reasons for allowance) can be given some weight by a reviewing court in determining the meaning of term(s) in the claims. The last two sentences of 1.109 do not preclude this result. Freeman v. 3M Co., 13 USPQ2d 1250 (Fed. Cir. 1989).

- **37 CFR 1.132 "opinion affidavits"**

Rule 132 affidavit which presents no additional objective evidence of non-obviousness, but simply presents the opinion of affiant regarding the "results which would likely be obtained" when operating within the scope of the appealed claims, is entitled to little weight. It is characterized as an "opinion affidavit." Ex parte Karol, 8 USPQ2d 1771 (BPAI 1988).

- **37 CFR 1.132 declarations**

Appellants have the burden of explaining the data in any declaration they proffer as evidence of non-obviousness. a mere reference to the declarations (37 CFR 1.132) does not adequately discuss the teaching of the declarants. A reference cannot be used as a 37 CFR 1.132 declaration. Ex parte Ishizaka, 24 USPQ2d 1621 (BPAI 1992).

- **37 CFR 1.136(a) & 1.137(b) no revival**

An extension of time fee under 37 CFR 1.136(a) must be paid within the maximum time permitted for extension by statute. Here, that time expired over one year before. Petition to revive under 37 CFR 1.137(b) was denied as it was filed more than one year after the date of abndmt (which was not extended because no R. 136 (a) fee was filed between SSP resp. date & 6 mo. FSP date). In re Application of S, 8 USPQ2d 1630 (Comr PAT & TM 1988)

- **37 CFR 1.137(a) unavoidable basis**

Petition to revive under 35 USC 133 and 37 CFR 1/137(a) as UNAVOIDABLE is granted because the attorney's interpretation of 37 CFR 1.8 on September 2, 1977 was not an unreasonable one. Also, since the record establishes an extraordinary situation, justice requires waiver under 37 CFR 1,137(c) of the need for a terminal disclaimer. IN re Wilson, 8 USPQ2d 1375 Comr. Pat & TM 1988).

- **37 CFR 1.195(c)(5) - brief on appeal**

37 CFR 1.192(c)(5) requires appellant to perform two affirmative acts in his brief: (1) state that the claims do not stand or fall together and (2) present arguments why the claims subject to the same rejection are separately patentable. Otherwise we can presume that the claims stand or fall together. Ex parte Schier, 21 USPQ2d 1016 (BPAI 1991)

- **37 CFR 1.196(b) alternative responses**

Claimed "piston" species not only fails to meet written description req. of 35 USC 112, it also lacks enablement under that Section, requiring undue experimentation to practice it. New grounds

of rejection by BPAI can be responded alternatively to examiner or BPAI, but not both. *Ex parte Ohshino*, 14 USPQ 1750 (BPAI 1989).

- **37 CFR 1.196(b):no new ground of rej.**

The criterion of whether a rejection is considered "new" in a decision by the BPAI is whether appellants have had a fair opportunity to react to the thrust of the rejection. The basic thrust of the rejection at the examiner and board levels was the same and appellants had fair opportunity to respond thereto. No new Rule 196(b) ground of rejection here

. *Ex parte Maas*, 14 USPQ 1762 (BPAI 1990).

- **37 CFR 1.617(b) OC/judgment aff'd**

Response to Rule 617(b) O.C. fails to meet the "good cause" requirement of that rule based on failure of counsel for junior party to fully appreciate the kind of corroboration needed to demonstrate a PRIMA FACIE case for an actual reduction to practice of the subject matter of the count before the senior party's filing date. Additional showing bad, also. *Hahn v. Wong*, 13 USPQ2d 1313 (CAFC 1989).

- **37 CFR 1.644(a)(2) petitions**

Petition to Com'r under 37 CFR 1.644(a)(2) must be filed within 15 days after entry of a final decision by the BPAI in an interference proceeding, so a decision may be rendered prior to the expiration of the 60-day period for seeking judicial review under 35 USC 142 and 37 CFR 1.304 (a). Belated petition OK'd here, but in future will be strictly construed. *Orikasa v. Oonishi* 10 USPQ2d 1996 (Comr Pat & TM 1989).

- **37CFR1.633(b) motion on 35 USC 102(f) OK**

Motion under 37 CFR 1.633(a) by Party A (inventors K&F) alleging unpatentability under 35 USC 102(f), because the proper inventor of the subject matter in issue is K&A&B (where B is the Sr. Party sole inventor) is a proper motion under this rule. It does not relate to priority of invention. Petitioners are entitled to a ruling on this motion by the EIC. It can be treated at final hearing. *Kramer v. Ballard*, 11 USPQ2d 1148 (BPAI 1989).

- **Abandonment - intent req'd under 102(c)**

A rejection under 35 USC 102(c) based on abandonment reversed. Examiner argued that applicant "effectively reduced to practice the claimed invention five years before he filed his application. There was no actual red. to practice, however, which is needed for 102(g) abandonment to occur. 102(c) abandonment requires intent. Delay in filing doesn't show intent to abandon under 102(c), *Ex parte Dunne*, 20 USPQ2d 1479 (BPAI 1991).

- **Actual red. to prac: drawings alone**

This claimed invention - a ballasting digester cover - was straightforward and its function readily calculated by persons with some engineering background

. The inventors indicated there was no need to test it to predict how it would function. Therefore, it was sufficiently reduced to practice when detailed drawings of it were produced. An "on sale" bar was found here. *Envirotech v. Westech*, 11 USPQ2d 1804 (DC D UT 1989).

- **Adequacy of disclosure - mult. arts**

When an invention, in its different aspects, involves distinct arts, that specification is adequate which enables the adepts of each art, those who have the best chance of being enabled, to carry out the aspect proper to their specialty. CCPA case cited in *Transco Products v. Performance Contracting*, 28 USPQ2d 1739 (DC ND IL 1993).

- **Alternative count language**

Alternative count language suggested in this decision: A copolymer of ethylene and styrene OR A method of making a copolymer of ethylene and styrene comprising copolymerizing ethylene and styrene. In this case, the material and method constitute the same patentable invention. *Orikasa v. OOnishi*, 10 USPQ2d 1996 (Comr Pat & TM 1989).

- **Amended spec.: new matter or not?**

Claims within an amended application are entitled to the effective filing date of the original application if the parent complies with the written des. req. of 112. The test is whether the original

disclosure reasonably conveys to the artisan that the inventor had possession at the earlier time of the later claimed invention. OK here. *Sun Products Group Inc. v. B&E Sales Co. Inc.* 9 USPQ2d 2009 (DC ED MI 1988).

- **Analogous prior art - similar problem**

References which pertain to a different field of endeavor may still be analogous prior art if they are reasonably pertinent to the particular problem with which the inventor is involved. Connector means for cover of device analogous to connectors for computer covers. *In re Paulsen*, 31 USPQ2d 1671 (CAFC 1994).

- **Anticipatory reference**

Anticipation of claims depends on whether prior art reference's total disclosure includes the subject matter of the claim and whether the reference places that subject matter in possession of one of ordinary skill in the art. *Ex parte Luck*, 28 USPQ2d 1875 (BPAI 1993)

- **Arguments of Counsel - not evidence**

Arguments of counsel cannot take the place of evidence. *In re DeBlauwe*, 736 F.2d 699, 222 USPQ 191 (Fed. Cir. 1984).

- **Attorney-client privilege**

Copy of portion of affidavit filed in connection with patent application, of which certain portions were highlighted by attorney, reflects attorney's thought processes, and thus is protected from discovery as either attorney-client privilege or work product. Draft patent application, along with atty's notes & comments is also privileged. *Rohm & Haas v. Brotech*, 26 USPQ 1800 (DC Del 1993).

- **Attorney disqualification: merged firms**

Two law firms merged. One had previously represented Plaintiff and the other had perviously represented Defendant. The merged firm was disqualified from representing plaintiff against defendant. Court discusses Disciplinary Rules under the Model Code of Professional Responsibility. Judge Archer dissented. *Picker Int'l v. Varian Associates*, 10 USPQ2d 1122 (Fed. Cir. 1989).

- **Best mode - con or c-i-p**

Inventor is not required to amend disclosure to disclose information learned after application is on file even if it would have been required best mode disclosure if know at time of application. But, if later learns of a best mode, he must disclose it in any continuing application (con or c-i-p). *Transco Products v. Performance Contracting*, 28 USPQ2d 1739 (DC ND IL 1993).

- **Best Mode - failure to disclose**

Claims for a flexible cable carrier are unenforceable due to failure to disclose best mode. *Katrapat AG v. Advanced machine & Engineering Co.*, 28 USPQ2d 1270 (DC NIII 1993).

- **best mode - inventor's knowledge alone**

Even though others working for Glaxo believed that azeotroping was the best mode for using a claimed composition, no evidence was presented showing that the named inventor knew that or attempted to conceal it. However, 35 USC 112 refers only to knowledge of the inventor and knowledge of others cannot be imputed to the inventor. *Glaxo v. Novopharm Ltd.* 29 USPQ2d 1126 (DC EDNC 1993).

- **Best mode - relates to claimed inv. only**

Best mode inquiry relates to what applicant regards as the invention, which in turn is measured by the claims. Unclaimed subject matter is not subject to the disclosure requirements of 35 USC 112. The disclosure would be boundless and, the pitfalls endless. The undisclosed mode related to an unclaimed aspect of the invention. *Engel Industries Inc v. The Lockformer Co.* 20 USPQ 1300 (CAFC 1991).

- **Best mode - two component analysis**

The best mode defense is of a mixed nature, with subjective and objective components. The subjective part is whether at the time the patent application was filed, the inventor knew of a mode for practicing his invention that he considered better than any other. The objective part is whether

his disclosure of that mode adequate to enable OOSITA to practice it. *Envirex v. FMC Corp.*, 28 USPQ2d 1752 (CAFC 1993)

- **Best Mode: testimony relevant**

Best mode issue turns on the evaluation of the testimony of the witnesses, as well as the technological significance of the structure, citing *Bernier v. DeGeorge*, etc. *Diversitech v. Century Steps*, 7 USPQ2d 1315 (CAFC 1988).

- **Binding BPAI & CAFC precedent on Exrs**

Where the CAFC or one of its predecessor courts) has addressed a point of law in a published opinion, that decision is controlling. Where the CAFC or its predecessor courts has not addressed an issue, but there is "authorized published" BPAI precedent, that precedent is binding on panels of the BPAI and Examiners in the Examining Corps. *Ex parte Holt*, 19 USPQ2d 1211 (BPAI 1991).

- **BPAI decides priority and patentability**

It was appropriate for the Board of Patent Appeals & Interferences to determine priority of invention in an interference proceeding, and to enforce the consequences thereof against the party held NOT to be the prior inventor, when the Board held that the count was not patentable to the prior inventor (because of an "on sale" bar in this case) *Perkins v. Kwon*, 12 USPQ2d 1308, Fed Cir. 1989).

- **BPAI opinion criteria & precedence**

Generally, the BPAI authorizes publishing of its opinions under certain enumerated circumstances. A published BPAI decision may be overruled only by the BPAI sitting EN BANC, or by an expanded panel. Only unpublished BPAI decisions "on all fours" (or substantially so) with the facts of a particular case are binding on Examiners. *Ex parte Holt*, 19 USPQ2d 1211 (BPAI 1991).

- **Claim - machine & process not in same cl**

Claim intended to embrace both product or machine and process is precluded by language of 35 USC 101, which sets forth statutory classes of invention in alternative only, and 35 USC 112, 2d para., because insofar as it seeks to be both a machine and a process is ambiguous. This is distinguishable from product-by-process claims, (directed to product only) *Ex parte Lyall*, 17 USPQ2d 1549 (BPAI-exp.pnl-1990).

- **claim interp. q of law "right angles"**

Claim interpretation is a question of law. In this case, there is no dispute over the meaning of the terms - they simply have their common ordinary meaning. The trial court misread the claims. The adjectival phrase "at right angles" relates to the relationship between the cap and cap face structure to the nut body - not to the weld itself. *Key Mfg. Gp. Inc. v. Microdot Inc.*, 17 USPQ2d 1806 (CAFC 1991).

- **Claim interpretation in PTO**

During patent examination, claims must be interpreted as broadly as they reasonably allow, in order to achieve complete exploration of applicant's invention and its relationship to prior art, so that ambiguities can be recognized, scope and breadth of language explored, and clarification imposed. *In re Zletz*, 13 USPQ2d 1320 (CAFC 1989).

- **Claim language - applicant's def'n OK**

Use of accepted generic expressions, e.g., "metal" and "wood" in claims precluding dependent claims from using Markush claim language is OK because an applicant has a right to define what he regards as his invention as long as it is reasonably distinct and supported by an enabling disclosure. *Ex parte Ohsumi*, 21 USPQ2d 1020 (BPAI 1991).

- **Claim language - comprising**

In patent law, in claims, the word "comprising" is open ended, one of enlargement and not of restriction; in contrast, the word "consisting" is one of restriction and exclusion. A "comprising-type count by definition does not exclude the presence of other steps, elements or materials." *Cues Inc v. Polymer Industries*, 8 USPQ2d 1847 (DC ND GA 1988).

- **Claim language violates 112, 2d para.**
Claim language "relatively shallow" which is not defined with more specificity in specification, is vague and indefinite and violates 35 USC 112, 2d para. When a word of degree is used in a claim, the specification must provide some standard for measuring that degree. *Ex parte Oetiker*, 23 USPQ2d 1651 (BPAI 1992), *In re Oetiker*, 23 USPQ2d 1665 (CAFC 1991).
- **Claim preamble "Personal Mobility Veh."**
Language in claim preamble of a "personal mobility vehicle" limits the claim and makes it comply with 35 USC 112, 2d paragraph. *In re Burke*, 22 USPQ2d 1368 (DC CD Cal 1992).
- **Claim preamble - life and meaning**
Limitations appearing in the preamble to patentee's claims are necessary to give life and meaning to the claims and to properly define the invention. *Diversitech Corp. v. Century Steps Inc.*, 7 USPQ2d 1315 (CAFC 1988).
- **Claim preamble - limiting prior art**
Claim preamble, "an apparatus for applying a coating on tablets," does not merely state one possible embodiment of invention but is essential to an understanding of claim itself, and thus, relevant prior art is limited to tablet coating machines and not other kinds of industrial drying machines. *Freund Industrial Co. v. Driam Metallprodukt*, 12 USPQ2d 1642 (DC SDNY 1989).
- **Claim preamble language: not limiting**
The claim preamble language "breast beam" and "breast plate" were used "only to fix the direction of the woven fabric on the loom" and do not constitute structural claim limitations. *Vaupel Textilmaschinen KG v. Meccanica Euro Italia s.p.a.*, 20 USPQ2d 1045 (CAFC 1991).
- **Claim preamble limitations in claim**
No litmus test can be given as to when the introductory words of a claim, the claim preamble, constitute a statement of purpose for a device or are, in themselves, additional structural limitations of a claim. In this case, the preamble do give life and meaning and provide further positive limitations to the invention claimed (optical fiber waveguides) *Corning Glass v. Sumitomo*, 9 USPQ2d 1962 (CAFC 1989).
- **Claim preamble statement of purpose only**
Claim preamble here is determined to be merely a statement of purpose. *In re Stencel*, 4 USPQ2d 1071 (CAFC 1987).
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Claim preamble here is determined to be merely a statement of purpose. *In re Stencel*, 4 USPQ2d 1071 (CAFC 1987).
- **Claim Preamble limits rel. prior art**
Claim preamble, "an apparatus for applying a coating on tablets," does not merely state one possible embodiment of invention but is essential to an understanding of claim itself, and thus, relevant prior art is limited to tablet coating machines and not other kinds of industrial drying machines. *Freund Industrial Co. v. Driam Metallprodukt*, 12 USPQ2d 1642 (DC SDNY 1989).
- **Claim recites alternative embodiments:OK**
These particular chemical claims are not rendered vague and indefinite simply because they contain alternative language which makes them clearly cover two compositional embodiments. *Ex parte Holt*, 19 USPQ2d 1211 (CAFC 1211).
- **Claim term meaning must make sense**
Claim construction is a matter of law and a claim phrase must be interpreted as it would be construed by one of ordinary skill in the art and understanding that an inventor is permitted to be his own lexicographer as long as idiosyncratic term usage is both comprehensible and reasonable : "a descriptive ratio less than 2." *Grain Processing v. American Maize-Prod.*, 21 USPQ2d 1474 (CAFC 1991) (Unpublished)
- **Claim to count correspondence**
When an interference is declared, there is a rebuttable presumption that different counts define separate patentable inventions; each claim corresponding to a count defines the same patentable

invention; and a claim not designated as corresponding to a count is not directed to the same patentable invention as the claims designated as corresp.to the count. *Orisaka v. Oonishi*, 10 USPQ2d 1996(1989)

- **Claims corresp to count not unpat.**
Claims which do not correspond exactly to a count in interference cannot be held unpatentable simply because the subject matter of the count has been determined to be unpatentable for obviousness; party can argue separately patentability of claims designated as corresponding to count. In *re Van Geuns*, 26 USPQ2d 1057 (CAFC 1993).
- **Claims must have single sentence format**
The MPEP requirement that claims be in single sentence FORM is a formal matter which does not interfere with applicant's substantive right of expression. This requirement is not inconsistent with the statute (35 USC 112,2d para.), the Rules of Practice or case law. Non-one sentence claims are properly OBJECTED to. In *re Fressola*, 22 USPQ2d 1828 (Comr. Pat & TM 1992).
- **Claims with new matter: use 35 USC 132**
Proper basis for rejecting claims that involve new matter, i.e., matter not contained in the originally disclosure, is 35 USC 132. *Baxter-Travenol Laboratories Inc. v. Abbott Laboratories*, 8 USPQ2d 1089 (DC ND IL 1988).
- **Claims: product by process**
Product-by-process claims cover only the process, not the product, in determining infringement. *Tropix Inc v. Lumigen Inc.*, 27 USPQ 1475 (DC DMass 1993)
However, in ex parte prosecution before the USPTO, the patentability of a product-by-process claim is determined on the basis of the product formed and not on the process. *Ex parte Jungfer*, 18 USPQ2d 1797 (BPAI 1997).
- **Commercial success - not effective here**
Where prior art renders the patent obvious, no amount of commercial success will render the invention nonobvious. *Three Degrees Enterprises v. Three Degrees Worldwide*, 22 USPQ2d 1357 (CA3CKT 1991).
- **Cold fusion rejections-101 & 112,1st OK**
Examiner did not err in rejecting claims for "cold fusion" of nuclear energy for lack of enablement under 35 USC 112 and as inoperative and lacking utility under 35 USC 101. (Harvey Behrend?)
Ex parte Dash, 27 USPQ2d 1481 (BPAI 1992).
- **Collateral Estoppel - Interference**
Collateral estoppel should not estop a former party to a patent interference proceeding from seeking allowance of a claim where he tried to add a broader count to the interference but was not allowed to do so. *Baxter International v. Cobe Laboratories*, 25 USPQ2d 2035 (DC NDIII 1992).
- **collateral estoppel - lost count**
Zletz, in ex parte prosecution of application after losing interference where Dist. Court held held that he did not actually reduce to practice lost count subject matter, is COLLATERALLY ESTOPPED from relitigating this issue that he lost in the interference from relitigating it before the primary examiner. In *re Zletz*, 13 USPQ2d 1320 (CAFC 1989).
- **Com'r can't strike an abandoned applic.**
35 USC 1.56 (Post-1982) provides for rejection of PENDING patent application only. It does not apply to abandoned patent applications. Commissioner has no authority to strike an abandoned patent application and Commissioner must reinstate the abandoned application. *Air Products and Chemicals v. Quigg*, 8 USPQ2d 2015 (DC, DC 1988).
- **Compelled examiner testimony is limited**
CAFC determined the extent to which a patent examiner may be compelled to testify with respect to the reexamination of a patent. It's OK to determine whether a party had submitted certain info, or whether specific prior art was before an examiner. It cannot probe the examiner's knowledge and thought processes. *Western Electric v. Piezo Technology*, 8 USPQ2d 1853 (Fed. Cir. 1988).
- **comprehensiveness of ref. not liability**

As a general principle, regarding either anticipation or obviousness, the comprehensiveness of an applied reference's disclosure does not derogate from its teaching effect, (e.g., the approximately 1.5 million compounds disclosed in the beilstein Handbook). Ex parte A, 17 USPQ 1716 (BPAI 1990).

- **Conception of all limitations. of count**

Jr. Party has not shown that every limitation of the count was known to him at the time, prior to senior party's filing, when Jr. party alleges to have conceived invention. Jr. party's evidence only shows an idea or desired result in his mind. Complete conception is lacking at any date prior to Sr. party's filing date. Geshwind v. Rodesh, 10 USPQ2d 2038 (Fed. Cir. 1989).

- **Conception of chemical compound**

Conception of chemical compound requires both idea of compound's structure and possession of operative method of making compound. Suh v. Hoefle, 23 USPQ2d 1321 (BPAI 1993).

- **Correction of Inv: 35 USC 116 vs. 256**

Once a patent has issued, inventorship may be corrected only under 35 USC 256 - and not under 35 USC 116, which relates only to correction of inventorship during the patent application process. Roach v. Crouch, 17 USPQ2d 1250 (DC, ND IA, 1990).

- **Counts:broadest possible interpretation**

Counts, absent any ambiguity, are to be given the broadest reasonable interpretation which they can reasonably support. Behr v. Talbott, 27 USPQ 1404 (BPAI expanded panel on recon 1992).

- **Court review of BPAI Int. Decisions**

By the terms of the 1984 amendments to 35 USC 184, parties to a decided patent interference proceeding can seek direct review in separate courts, i.e., an appeal to the CAFC or via a civil action in a U.S. District Court. One party may choose one route and the other party the other route at the same time. Parallel and simultaneous review routes are available. In re Van Geuns, 20 USPQ2d 1291 (CAFC 1991).

- **Data structures - app/article claims OK**

Claims to "A memory for storing data . . . comprising a data structure of attribute data onjects (ADOs) . . . were found to be statutory subject matter under 35 USC 101. In re Edward S. Lowry, CAFC Slip Op. 8/29/94, SN 07/181,105. (different result re data structures in method claims - see In re Warmerdam, 31 USPQ2d 1754, 1760 (CAFC 1994)).

- **Date of publication - after filing date**

To the extent that a publication with a publication date subsequent to applicant's effective filing date establishes the level of ordinary skill in this art at and around the time of the present invention, it is properly relied upon by the examiner in rejecting the present claims under 35 USC 103. Ex parte Erlich, 20 USPQ 1463 (BPAI 1992), citing Thomas & Betts v. Litton Systems, 220 USPQ7 (CAFC 1983).

- **Design patent benefit from utility app.**

The CAFC overruled, en banc, the decision in In re Campbell, 101 USPQ 406 (CCPA 1954) which held that "an application for a design patent cannot be a division of an application for a mechanical patent, and thus entitled to the benefit of its filing date." Racing Strollers Inc. v. TRI Industries Inc. 11 USPQ2d 1300 (Fed. Cir. 1989).

- **Design patent public use bar -102(b)**

A table embodying applicant's design, claimed in a design patent application, which was displayed at a trade show more than one year before the filing date of the design application constitutes a statutory bar under 35 USC 102(b). Design patents have almost no scope, the claim being limited to what is shown in the application drawings. In re Mann, 8 USPQ2d 2030 (Fed. Cir. 1988).

- **Diligence - all circumstances considered**

Diligence does not require that inventor be working on the invention every day but rather, must be considered in light of all circumstances. Diligence was shown here despite fact that patent holder's logbook shows many days on which work was not being done. Hybritech Inc. v. Abbott Laboratories, 4 USPQ2d 1001 (DC Cal 1987).

- **Diligence outside US no good**

Conception is Switzerland, alleged introduction of conception into US before other party's actual reduction to practice, and actual red. to practice after other party's red. to practice. Diligence alleged but it took place outside of US, so it was no good. *Staehelin v. Secher*, 24 USPQ2d 1513 (BPAI 1992).

- **Discovery - contention interrogatories**

Contention interrogatories, rather than depositions under FRCP 30(b)(6) are most appropriate in a patent action. *McCormick -Morgan, Inc. v. Teledyne Industries, Inc.*, (21 USPQ2d 1412 (DC N CAL 1991).

- **Discovery about derivation: requirements**

Motions for add'l discovery under 37 CFR 1.287(c) alleging derivation must allege in clear and unequivocal terms that he communicated the invention to the party he alleges derived it from him. That was done here. Opposer failed to establish earlier conception re one of two counts. Testy will not be reopened to let opposer shore up his case. *Asari v. Zilges*, 8 USPQ2d 1117 (BPAI 1988).

- **Double patenting - claims not prior art**

No double patenting exists here between two patentably distinct claims, one directed to a decaffeinating process and the other to a process for the recovery of caffeine. *General Foods v. Studiengesellschaft Kohle mbH*, 23 USPQ2d 1839 (CAFC 1992). Can't treat the claims of one application as prior art against the other application claims, either.

- **double patenting - one way**

One way double patenting test used by examiner was OK because applicant caused the delay responsible for this application by filing a continuation rather than contesting the rejection in the original application. *In re Braat*, 16 USPQ2d 1812 (CAFC 1990); *In re Goodman*, 29 USPQ2d 2010 (CAFC 1993).

- **Drawings - written desc. measurements**

Patent Drawings are not working drawings and are not to scale so length measurements cannot be made from them. *In re Wilson & Corns*, 136 USQ 188 (CCPA 1963), *In re Wright*, 193 USPQ 332 (CCPA 1977). But angular measurements can be made from patent drawings, *In re Mraz*, 173 USPQ 25 (CCPA 1972). Also, see *In re Meng & Driessen*, 181 USPQ 94 (CCPA 1974) for a holding that drawings can be applied in determining patentability.

- **Duty of candor - red flag. react also**

Duty of candor has many ramifications, including duty to disclose or even to "red flag" contradictory information regarding test results, and has a duty not only to disclose close pertinent prior art reference, and not to "bury" it within other disclosures of less relevant prior art. Disclose to PTO any misstatements to cure ineq. cond. before patent issues. *Golden Valley MFI v. Weaver PCI*, 24 USPQ2d 1801 (DCNDIN 1992)

- **Each case decided on its own merits**

Patentability argument based on assertion that PTO continues to issue patents on similar subject matter. No credit given to argument because EACH CASE MUST BE DETERMINED ON ITS OWN MERITS. *Ex parte Erlich*, 22 USPQ2d 1463 (BPAI 1992).

- **Earlier corresponding foreign patents**

Patent attorney prepared a Rule 131 affidavit to swear behind U.S. patents, despite being under an obligation to determine the existence of corresponding foreign patents with respect to which the Rule 131 affidavit would not be effective. Court said that determination of these corresponding foreign documents would have been "simple." *Hoffman-La Roche Inc. v. Lemmon Co.*, 13 USPQ 1224 (DC ED PA 1989).

- **Enablement - key is undue experimentation**

Enablement - That some experimentation is necessary does not constitute a lack of enablement; the amount of experimentation, however, must not be unduly burdensome. Enablement is a question of law. Note that a claim that covered thousands of compounds was held to satisfy section 112's enablement requirement. Undue experimentation is the key to enablement. ADAHF

v. Bisco Inc, 24 USPQ2d 1524 (DC ND ILL 1992).

- **Enablement - lack of (enzyme)**
Application teaching use of enzyme which provides a measurable signal in the presence of theophylline as a method for determining concentration of that alkaloid in a sample does not satisfy 35 USC 112 enablement requirement. 28 USPQ2d 1391 (BPAI 1993).
- **Enablement - obj. std.; no undue exper.**
Although 35 USC 112, 1st para. requires that the specification teach those in the art to make and use the invention without "undue experimentation." That SOME experimentation is required is not fatal. 112,1st requires only OBJECTIVE enablement - regardless of how it is set forth, e.g., using illustrative examples or by broad terminology. In re Vacek, 20 USPQ2d 1438 (CAFC 1991).
- **Enablement - OK re any claimed mode**
The enablement requirement of 35 USC 112 is separate and distinct from the best mode requirement. If the description enables ANY MODE of making and using the claimed invention, the enablement requirement is met. Engel Industries Inc. v. The Lockformer Co., 20 USPQ 1300 (CAFC 1991).
- **Estoppel - none after this interference**
Appellant (before the BPAI)'s failure to propose his claims on appeal in a previous interference with party A, where party A clearly conceded that he was not the first inventor thereof, did not create an estoppel against appellants. Estoppels, when asserted against statutory rights, should never be applied based on conjectural or hypothetical premises. Ex parte Rohrer, 20 USPQ2d 1460 (BPAI 1991).
- **Estoppel - orig. app. to CIP**
Estoppel only arises when a clear, unambiguous rejection gives rise to a choice of appealing or accepting the rejection, and the applicant accepts the rejection and expressly or impliedly concedes its correctness. Here there was no 112, 1st para. rejection, only objections made in the parent. No estoppel absent explicit final rejection under Sec. 112, 1st para., Waldemar v. Osteonics, 31 USPQ2d 1855 (CAFC 1994).
- **Estoppel re evid, in 35 USC 146 proc.**
Former Interference party who had opportunity to have raised evidentiary issue regarding 356 USC 102(b) bar in interference, but didn't, is precluded from introducing that evidence in a 35 USC 146 proceeding subsequent to the interference. 24 USPQ2d 1395 (CAFC 1992). Orig. case decided by Dist. CT. 24 USPQ2d 1393 (DC EDPA 1992).
- **Estoppel: Prosecution history**
Prosecution history estoppel in a patent that went to the Board and then to court. Haynes International Inc. v. Jessop Steel Co., 28 USPQ2d 1652 (CAFC 1993).
- **Failure to exhaust admin. remedies**
Plaintiff sued the USPTO concerning the rejection of his application. He filed a Notice of Appeal, then failed to file a brief. The court held that applicant failed to exhaust his administrative remedies and that proper venue is the District Court, DC. Court lacks subject matter jurisdiction. Stagner v. USPTO 22 USPQ2d 1397 (DC DKAN 1992).
- **Gov't inventor - title to invention**
Invention made as a consequence of a federal employee inventor's official duties, even though made while the inventor was on leave, because he became aware of the problem to be solved through government info, and used gov't material and equipment in addition to his own money and time. Menke v. Department of the Army, 20 USPQ2d 1386 (USDOC, Undersecretary for Technology, 1991).
- **Hearsay OK in ex parte pat. examint'n**
The inapplicability of hearsay evidence rules in ex parte PTO examination is appropriate in light of purpose and reason for the hearsay rule. If applicants want to cross-examine the authors of written hearsay assertions, under 35 USC 184, they can bring a civil action in the DCDC to do so. No evidence in record to rebut presumed accuracy and reliability of refs. In re Epstein, 31

USPQ2d 1817,1821 (CAFC 1994)

- **Improper Incorp. by ref. of U.S. Pat.**

The general incorporation by reference of a U.S. patent in appellant's specification meets the enablement requirement of 35 USC 112, 1st para., but does not meet the written description requirement of that statute in this case because its incorporating statement does not clearly identify the subject matter which is incorporated and where it is to be found. Ex parte Raible, 8 USPQ2d 1709 (BPAI 1988).

- **Inad. resp. to R. 617(a) OC:corrob. issu**

Response to Rule 617(a) Order to Show Cause insufficient to let interference go forward. Two EICs dissented. Held: Inadequate corroboration of alleged actual reduction to practice. Not reasonable to conclude that ANY independent knowledge can be imputed to the two corroborators. Good cause to supplement showing was not shown. Hahn v. Wong, 13 USPQ 1211 (BPAI 1989).

- **Incorp. by Ref.- essential/nonessen.mat.**

Instant applic. disclosed and claimed Br* subject matter. It claims benefit under 35 USC 120 of parent applic. A that does not claim Br* but incorporates disclosure of Br* from applic. B, which is incorp. by ref. into applic. A. Applic. A claims benefit under 35 USC 119 of for. applic. disclosing Br* subj. matter. Held: Instant applic has both 120 and 119 benefit of Br*. Ex parte Maziere, 27 USPQ2D 1705 (bpai 1993).

- **Indef-can't reject on obviousness**

Claims invalid for being vague and indefinite under 35 USC 112, second paragraph. A recumbent bicycle claim. Claims invalid for indefiniteness cannot also be invalid for obviousness since a finding of obviousness would require reliance on speculative assumptions as to meaning of claims. Ex parte Brummer, 12 USPQ2d 1654 (BPAI 1989).

- **Indef. claims - don't rej. on prior art**

Claims rejected as vague and indefinite under 35 USC 112, 2d para. were also rejected as obvious over a reference. However, since no reasonably definite meaning can be ascribed to certain language in the claim, it is improper to reject on speculative assumptions about claim meaning. This reversal of the art rejection is not on the merits, but is procedural based on indefiniteness. Ex parte Brummer, 12 US{Q2d 1654 (BPAI 1989)

- **Indefinite Claims - 35 USC 112, 2d para.**

Claims for a preloiad test circuit for programmable logic arrays are indefinite because the term "connection" can mean "linK, and so interpreted, claim 1 recites three points in space which rendered claim completely indefinite since claims 2 and 3 add no saving structural limitations and are also indefinite. Texas Instruments v. Cypress Semiconductor, 28 USPQ2d 1154 (CAFC 1993).

- **Inherency - cautiously reject on**

The mere fact that thing may result from a given set of circumstances is not sufficient to establish inherency. That which may be inherent is not necessarily known. Obviousness cannot be predicated on what is unknown. A retrospective view of inherency is not a substitute for some teaching or suggestion supporting an obviousness rejection. In re Rijckaert, 28 USPQ2d 1155,1957 (CAFC 1993).

- **Int- redto prac, claim preamb not limit**

Claim preamble language is not limiting here. It merely indicates the enviroment in which the claimed invention operates. The preamble recitation of the "tread strip" is not a claim limitation. The BPAI erred by concluding that appellants had to test their invention with a preformed tread strip. Tests demonstrated actual reduction to practice. C.R.Bard v. The Kendall Co., 21 USPQ2d 1462 (CAFC 1991 unpub.)

- **Int. scope of count**

Proposed count improper because it included limitation not present in Sr party's claims corresponding to the count or his benefit case. Burden to persuade/go forward re 1.633 motions,

citing 1.637's requirements. *Choing v. Roland*, 17 USPQ2d 1541 (BPAI-EIC-1990)

- **Int. Setting Testy after decising motion**

After denying and dismissing various motions, EIC notified parties of service of prelim. statements (PS) and set testy - also made suggestions for negotiations. *Chiong v. Roland*, 17 USPQ2d 1541 (BPAI(EIC)1990).

- **Intended Use in app. claim: no wieight**

Claimed centrifuge differs from prior art centrifuge only its claimed intended use (for blood). However, the manner or method of use of a machine isn't germane to the patentability of the machine itself. A statement of intended use does not distinguish the structural apparatus claimed over the prior art ref. The rejection is sustained. *Ex parte Cullis*, 11 USPQ2d 1876 (BPPAI 1989).

- **Interf: showing needed for expert testy**

A proper motion under 37 CFR 1.639 to take testy failed to describe the nature of the testimony needed where the testimony of an expert was involved. This decision sets forth guidelines to follow in such instances. It also expressly overrules *Verbruggen v. Wells*, 5 USPQ2d 1983 (Comr.Pat 1987) and *Nabial v. May*, 2 USPQ2d 1452 (Comr.Pat 1986), *Hanagen v. Kimura*, 16 USPQ2d 1791 (Comr. Pat 1990).

- **Interference - 37 CFR 1.287(c) sanctions**

Opposer of motion for additional discovery under 37 CFR 1.287(c) refused to answer several interrogatories he was ordered by BPAI to answer, citing FRCivP Rule 33. BPAI distinguished FRCivP and 37 CFR 1.287 procedures and ordered communication of the invention to opposer as of specific date. *Asari v. Zilges*, 8 USPQ2d 1118 (BPAI 1987).

- **Interference - Burden of Proof**

BPAI's and Commissioner's interpretation that new interference rules place the burden of proof on a party filing a preliminary motion under section 1.633(g) is reasonable. Wee agree. Permission to refile motions under 1.633(A) and (g) permissible since this interpretation is new.

- **Interference - piecemeal motions w testy**

Ordinarily, preliminary motions should be supported by facts which would justify granting the motion, 37 CFR 1.639(a). It is not appropriate to file a motion, see if the motion will be granted, and then ask for testimony only after the motion is denied. However, given the state of the law at the time the parties requested testy, in this instance, we'll consider the testy. *Sta-helin v. Secher*, 24 USPQ2d 1513 (1992)

- **Interference -intro into US & not briefed**

Sr. party allegedly conceived invention of count in Sweden & brought it into U.S.. Board found that Sr. Party's bringing into the U.S. of bacteria plates containing a gene library of 504 clones failed to constitute conception and reduction to practice of the count. *Colbert v. Lofdahl*, 21 USPQ2d 1068 (BPAI 1991). Also, matters not briefed are ordinarily regarded as abandoned.

- **Interference -mos. for testy denied**

Motions to take testimony denied - one for failure to show evidence was unavailable at time it filed prelim. mos. or oppositions under 37 CFR 1.633(c) and, (2) because potential witnesses were not identified, specific facts to be testified to were not presented in sufficient detail per 37 CFR 1.639(c). *Okada v. Hitotsumachi*, 16 USPQ2d 1789 and *Hanagen v. Kimura*, 16 USPQ 2D 1791 (BPAI 1990), respectively.

- **Interference Burden of Proof - C&CE**

Clear & convincing evidence must be shown by junior party to establish conception, communication and diligent reduction to practice. PAI erred by requiring junior party to satisfy burden of proof beyond reasonable doubt. *Price v. Symsek*, 26 USPQ2d 1031 (CAFC 1993).

- **Interference counts - sp. terms**

Interference counts are to be given their broadest reasonable interpretation. Terms construed include "heat exchanger", "flow therethrough" and "flow through". *Davis v. Loesch*, 27 USPQ 1440 (CAFC 1993).

- **Interference pub. use - prepond. of evid**

A preponderance of the evidence standard applies in a patent interference proceeding on the issue of public use, even though junior party applicant alleges senior party patentee's invention was in public use. *Schrag v. Strosser*, 21 USPQ2d 1025 (BPAI 1991).

- **Interference-in-fact:burden & definition**

V seeks to establish that his claims are patentably distinct from W's claims 1 - 10. The BPAI correctly characterized this as whether an interference-in-fact is presented and properly placed the burden of proof on V (the patentee). Int -in-fact is defined by 37 CFR 1.601(j). *Verbruggen v. Wells*, 16 USPQ2d 1314 (Fed. Cir. 1990).

- **Interference: prelim motions under 1.633**

A preliminary motion under 37 CFR 1.633 to designate certain listed claims as NOT corresponding to the count was denied, but should have been dismissed since the Rules of Practice do NOT provide for amending or adding claims for the purpose of having them designated as NOT corresponding to the count. *L'Esperance v. Nishimoto*, 18 USPQ2d 1534 (BPAI 1991).

- **Interference:belated motions req. testy.**

Belated motion for testy denied because Jr. Party did not show, during prelim. motion period, that a testy period was needed to resolve any motion. Motion is for JJ based on no-interference-in-fact - an issue on which movant Jr. party has burden. This case overrules *Verbruggen v. Wells*, 5 USPQ2d 1983 (Comr.Pat 1987) and *Nabial v. May*, 2 USPQ2d 1452 (Comr. Pat 1986). *Okada v. Hitosumachi*, 16 USPQ2d 1789 (Comr. Pat 1990).

- **Interference:Fraud treated prospectively**

Old Rule Interference Motion to dissolve based on inequitable conduct which wasn't learned of until witness' testimony in interference proceeding was dismissed in view of policy then in effect that such issues were not cognizable in interferences. Subsequent OG Notice permitting treatment of these issues "effective immediately" meant prospective,not retrospective treatment. *GB v. CR*, 23 USPQ2d 1158 (BPAI 1992).

- **Interviews in reexam- standards**

In a reexamination proceeding interviews are conducted in accordance with MPEP secs. 713.01 - 713.04. The examiner did not abuse any discretion in denying an interview in this reexam because it was neither necessary or appropriate since the issues were clearly presented by the parties on the record. In re *Chambers*, 20 USPQ2d 1470 (Comr. Pat. & TM 1991).

- **Interviews in reexams**

- **Intf: JJ against both part. re prior art**

EIC moved SUA SPONTE under 37 CFR 1.610(e), 1.633(a) and 1.641 for judgment on the ground that all the claims of Jr. Party are unpatentable under 35 USC 102(b) and/or 35 USC 103 over prior art. Order to Show Cause under 37 CFR 1.640(d) issued. At final Hearing, BPAI awarded judgment against BOTH parties based on unpatentability over that prior art. *L'Esperance v. Nishimoto*, 18 USPQ2d 1534 (BPAI 1991).

- **Inventorship - not joint inventor here**

Designer of hardware structure for circuit chip[used in component of computer tomographer scanner was not a joint inventor because the hardware design was dictated explicitly by the inventor's specification and reflected simply normal skill expected of ordinary chip designer and did not involve any inventive acts. *Sewall v. Walters*, 30 USPQ2d 1356 (CAFC 1994)

- **Inventorship change - need evidence**

Although amendments of inventorship under 35 USC 116 should be liberally allowed, the PTO must be assured of the presence of innocent error before permitting substitution of a true inventor's name. There must be some evidence other than bare conclusory statements to convince the PTO that an error occurred. *Coleman v. Dines*, 224 USPQ 857 (CAFC 1985).

- **Inventorship-correction in patent-no dil**

Correction of inventorship. 37 CFR 1.48, which implements 35 USC 116 (correction of inventorship of a pending patent application), requires diligence, but neither 35 USC 256 nor 37

CFR 1.324, regarding correction of inventorship of issued patents, requires diligence. A diligence requirement must be determined on the facts of each case. *Stark v. Advanced Magnetics, Inc.*, 31 USPQ2d 1290 (CAFC 1994).

- **Inventorship:applic. of "all claims" rule**

1984 amendments to 35 USC 103 stated that pending cases rights were to be determined on the basis of "substantive law" in effect prior to the enactment date. CAFC found that, regarding inventorship, the "all claims" rule was NOT uniformly accepted as "the substantive law." Thus, that rule did not apply in this case. *Smithkilne Diagnostics Inc. v. Helena Laboratories Corp.*, 8 USPQ2d 1468 (Fed. Cir. 1988).

- **Issue fee due:fee increase result**

New (1989) PTO policy on payment of Issue Fees when a fee increase goes into effect is that payment of the lower fee amount indicated in the Notice of Allowance by the due date, although lower than the increased Issue Fee amount, will not result in abandonment of the application. The PTO will mail a three month Notice to applicant to make up the difference. *In re Mills*, 12 USPQ2d 1847 (Comr. Pat & TM 1989).

- **Judicial Notice - standard reference OK**

BPAI added a new reference and affirmed a rejection. Where such a reference is a standard work, cited only to support a fact judicially noted and the fact, as here, plays a minor role, serving only to fill in the gaps which might exist in the evidentiary showing of the examiner to support a particular ground of rejection, it's OK. *In re Boon*, 169 USPQ 231 (CCPA 1971).

- **Level of skill in the glassware art**

Claimed invention deals with the method used in the hollow glass industry to remove the hollow molded ware from the I.S. machine dead plate to a conveyor belt, i.e., a seep-out or take-away device. The art includes the glassware making industry, robotics and electronic circuitry. Skilled workers were EE and ME engineers and those with equivalent on the job experience. *CSS Int. v. Maul Tech.*, 16 USPQ2d 1657 (DC, SD IND 1989).

- **Level of skilled worker in polymer art**

The level of ordinary skill in the art of (1) mixing, and diluting or (2) mixing, diluting and activating liquid polymer is an individual with a high school education and approximately two years of experience in the field. *Stranco Inc. v. Atlantes Chemical Systems Inc.*, 15 USPQ 1704 (DC, SD TX 1990).

- **Lost count doct. & estoppel N/A here**

Lost count doctrine and estoppel do not apply to appellants because, although they lost one interference, they won another, and in the one they won, the subject matter of those counts corresponds to the claims on appeal. Rejections under 35 USC 102(e) and 102(g) are not applicable, either, because of derivation from appellant. *Ex parte Rohrer* 20 USPQ2d 1460 (BPAI 1991).

- **Means + Function - 35 USC 112, 6th para.**

Means-plus-function claims have to be interpreted under sixth paragraph of 35 USC 112. This interpretation does not conflict with principle that claims are to be given their broadest reasonable interpretation. *In re Donaldson*, 29 USPQ2d 1845

- **Meets 35 USC 101 and 35 USC 112, 6th .**

Claim for an autocorrelation unit (device) determined to constitute statutory subject matter under 35 USC 101, even though it operates according to an algorithm. 35 USC 112, para 6, also discussed - making the claims cover the corresponding structure, means or acts described in the specification and equivalents thereof. *In re Iwahashi*, 12 USPQ2d 1908 (Fed. Cir. 1989).

- **Method claim must have pos. steps**

Method claims reciting only "using the monoclonal antibodies of claim 4 to identify human fibroblast interferon" or "to isolate and purify human fibroblast interferon" violate 35 USC 112, 2d para because they fail to recite any active, positive steps delimiting how this use is practiced. *Ex parte Erlich*, 3 USPQ2d 1011 (BPAI 1987)

- **Misrepresentation re 37 CFR 1.312 amend.**
 Applicant argued that Rule 312 amendment's primary purpose was to correct certain typographical errors, saying that the corrections merely add to the clarity and readability of the specifications. Ct found this to be misrepresentation as the amendments changed the actual meaning of the spec. and were substantive changes. *Northern Telecom Inc. v. Datapoint Corp.* 9 USPQ2d 1577. (DC ND TX 1988).
- **Moving party bears burden of proof**
 With respect to all motions brought under the new interference rules (37 CFR 1.601 et seq.) the moving party bears the burden of making out a prima facie case of entitlement to the relief sought. So, a party moving for judgment under 37 CFR 1.633(a) on the ground that an opponent's claims are unpatentable to the opponent always bear the burden of proof. *Behr v. Talbott*, 27 USPQ 1401, (BPAI expanded panel on recon 1992).
- **MPEP describes patent practices**
 MPEP states that it is a reference work on patent practices and procedures and does not have the force of law, but it "has been held to describe procedures on which the public can rely." *Allegheny Ludlum Inc v. Comer*, 24 USPQ2d 1771 (DC WD PA 1992).
- **New use of old comp. not patentable**
 Claims to adhesive compositions rejected under 35 USC 102/103 as anticipated or obvious over 1 reference. PTO made prima facie case of anticipation which was not overcome by applicant. The discovery of a new property of a previously known composition, even when that property and use are unobvious from the prior art, can not impart patentability to claims to the known composition. *In re Spada*, 15 USPQ2d 1655 (Fed. Cir. 1990).
- **No "on sale" bar: no actual red, to prac,**
 35 USC 102(b) "on sale" bar NOT found here. The court focused on the fact that there was no actual reduction to practice more than one year prior to patent filing date despite fact that offer to sell was more than 1 yr prior to filing date. *Pfaff v. Wells Electronics*, 9 USPQ2d 1366 (DC ND IND 1988).
- **NO 35 USC 102(b) bar: testy conflict**
 Graduate student's technical memo stored in vault at Stanford Res. Inst. Library, with each copy thereof numbered and kept under control, was listed in the catalog, but was not available to the public. Testy conflict on whether owner would have let public see it. Court held that it was not a printed pub. under 35 USC 102(b) on this record. *RCA v. Data General*, 8 USPQ2d 1305 (DC Del 1988).
- **No abd, supp & Conceal here: 15 Mo. delay**
 Abandonment, suppression & concealment cases fall in two categories: Deliberate is the first. The second is a legal inference based on too long a delay in filing after an actual red. to practice. 15 month delay in this case is not per se reasonable, but is reasonable with the mitigating factors present in this case. *Engelhard Corp. v. M.C. Canfield Sons*, 13 USPQ2d 1561 (DC DNJ 1989).
- **No access to incorp. mat. under FOIA**
 Issued patent incorporated by reference the disclosure of a pending patent application. Plaintiff sought access to pending application under Freedom of Information Act (FOIA). Court said that the pending application was exempt from disclosure under FOIA, despite the fact that it may be available via an admin. process outlined in *In re Gallo*, 231 USPQ 496 (1986). *Leeds v. Quigg*, 11 USPQ2d 1574 (DC DC 1989).
- **NO estoppel to claim joint inventorship**
 Unlike the FRCivP, Patent Interference Rules do not permit a party to plead alternative theories of recovery. M could have only argued in the interference that he was a joint inventor at the cost of foregoing his claim to be a sole inventor. This justifies not holding him estopped in this civil action from claiming to be a joint inventor. *McSherry v. Gianuzzi*, 12 USPQ2d 1801 (DC, SD NY 1989).
- **No mode = no enablement (no conceal)**

A party's failure to disclose any mode of carrying out the invention of interference count raises an issue of that party's compliance with the written description requirement of 35 USC 112, NOT THE BEST MODE REQUIREMENT, since there is no evidence of concealment. *Bigham v. Godtfredsen*, 8 USPQ2d 1266 (CAFC 1988).

- **No on sale bar: sale was of another inv.**

An "on sale" bar was not found here. The disclosure in a bid of another invention than the one patented does not constitute an "on sale" bar of the patented invention. *Envirotech Corp. v. Westech Engineering Inc.*, 15 USPQ 1230 (Fed. Cir. 1990).

- **Non-copied claim not prior art here**

Rejection of claims over patent claim that applicant refused to copy is not sustained. That claim does not represent prior art to applicant because applicant does not have 35 USC 112, 1st para. support for the claim. *Ex parte Cullis*, 11 USPQ2d 1876 (BPAI 1989).

- **Non-enablement found: Biochem case**

With respect to a prima facie case of non-enablement, a single embodiment may provide broad enablement in cases involving predictable factors, such as mechanical or electrical elements. Here, we do not have adequate representative examples that vectors and yeast transformants within the scope of the claims can be prepared and used. *Ex parte Hitzeman*, 9 USPQ2d 1821 (BPAI 1988).

- **Obv-type Dbl pat. v. std obv. rejections**

There is a basic difference between obviousness-type double patenting rejections and standard obviousness rejections. Double patenting depends on what is CLAIMED in a patent. Obviousness relates to what is DISCLOSED (whether or not claimed) in any prior art reference (patent or not). *In re Bartfeld*, 17 USPQ2d 1885 (Fed. Cir. 1991).

- **Obviousness - no advance in art OK**

The quality of a ceramic is achieved differently by appellant than by the prior art reference and nothing in the prior art suggests the difference. PTO's argument that claimed invention is a simpler process than that of prior art and would be obvious based on "common sense" is not convincing. *In re Wank*, 17 USPQ2d 1894 (Fed. Cir. 1990).

- **Obviousness - reas. expect. of success**

Obviousness does not require absolute predictability of success; rather, all that is required for obviousness under 35 USC 103 is a "reasonable expectation of success." *Amgen Inc. v. Chugai Pharmaceutical Co. Inc.*, 13 USPQ2d 1737, 1765 (DC MASS 1989).

- **Obviousness - combined teachings of refs**

The test for obviousness under 35 USC 103 is what the combined teachings of the applied references, when taken as a whole, would have suggested to one of ordinary skill in the art. *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

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- **Obviousness - Combining Ref's. improper**

Motivation for combining prior art references need not be explicitly found in references themselves, and may be based on logic and sound scientific reasoning. Improper combination of references here. *Ex parte Levengood*, 28 USPQ2d 1300 (BPAI 1993).

- **Obviousness - conflicting teachings**

When one prior art reference's teachings conflict with those of another, the Board must weigh each reference for its power to suggest solutions to one of ordinary skill in the art. References here are in analogous fields of endeavor and render claimed invention obvious. *In re Young*, 18

USPQ2d 1089 (CAFC 1991).

- **Obviousness - improper motivation**

Motivation for combining prior art references need not be explicitly found in references themselves, but may be found in logic and sound scientific reasoning. No such showing here, however. Ex parte Levengood, 28 USPQ2d 1300 (BPAI 1993).

- **Obviousness - motivation**

Motivation for combining references need not be explicitly found in references themselves, and examiner may provide explanation based on logic and sound scientific reasoning that will support a holding of obviousness. Examiner did not do that here, however. Ex parte Levengood, 28 USPQ2d 1300 (BPAI 1993).

- **Obviousness - no solution/no unexpected**

Invention is obvious where the claimed feature solves no stated problem and produces no unexpected result, In re Kuhle, 188 USPQ 7 (CCPA 1975).

- **Obviousness - prima facie case**

A prima facie case of obviousness is established where the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having those teachings before him to make the proposed combination or modification, In re Lightner, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972).

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- **Obviousness - prima facie case by extr**

In rejecting claims under 35 USC 103, the examiner bears the initial burden of presenting a prima facie case of obviousness, which is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to one of ordinary skill in the art. In re Rijckaert, 28 USPQ2d 1955 (CAFC 1993).

- **Obviousness - ref-by-ref attack no good**

References, in determining obviousness are not read in isolation but for what they fairly teach in combination with prior art as a whole, and thus patent assignee's reference-by-reference attack on prior art to demonstrate non-obviousness is not persuasive. (Photoelectric sensing system) Banner Engineering v. Tri-Tronics Co. Inc., 29 USPQ 1392 1389 (CAFC 1993 unpub) citing in re Merck, 231 USPQ 375 (CAFC 1986).

- **Obviousness-proper determiner of fact**

BPAI, not the reviewing court, is the proper finder of fact in determining obviousness of claims and BPAI will not be reversed in close case of obviousness if no showing of clear error has been made and applicant fails to demonstrate BPAI's conclusion was erroneous. In re Andros, 28 USPQ 1146 (CAFC 1993).

- **Obviousness-reas, likelihood of success**

Combined prior art refs. provided a reasonable likelihood of success because it indicated critical parameters for lubricants applied to magnetic recording media, offered direction as to class of lubricants likely to be successful, and provided more than general guidance in a recognized area of technology. Absolute predictability not required. Claimed invention was obvious. In re Ball Corp., 18 USPQ2d 1491 (CAFC 1991).

- **obviousness-type double patenting test**

The test for obviousness-type double patenting is not whether the claims in one application are broader than the claims in another application. The test is whether the claimed invention in the subject application would have been obvious from the subject matter of the claims in the other application. Ex parte Oetiker, 23 USPQ2d 1651 (BPAI 1992).

- **Obviousness: Combining references**

Split CAFC decision finding nonobviousness. One reference said that coating a glass lens with a plastic aspheric outer layer in a non-preferred embodiment. Board said that rendered claimed invention obvious. CAFC said it taught away from using that combination and reversed. Judge Archer dissented and went along with the BPAI. *In re Braat*, 16 USPQ2d 1812 (Fed. Cir. 1990).

- **Obviousness: Equivalence not obviousness**

A conclusion of equivalence, even assuming it is accurate, does not support a conclusion of obviousness. The mere existence of functional equivalence does establish obviousness, *In re Scott*, 323 F.2d 1016, 139 USPQ 297 (CCPA 1963); *In re Edge*, 359 F.2d 896, 149 USPQ 556 (CCPA 1966), and *In re Flint*, 330 F.2d 363, 141 USPQ 299 (CCPA 1964) - see MPEP 706.02.

- **Obviousness: not same problem solved**

A prima facie case of obviousness does not require that the prior art references necessarily recognize or even suggest the problem which applicant attempted to solve. *In re Dillon*, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1990).

- **Obviousness: Inherency not same as known**

The retrospective view of inherency argued by the Solicitor is not a substitute for some teaching or suggestion that supports the selection and use of the various elements in the claimed combination. That which is inherent is not necessarily known - obviousness cannot be based on what is unknown. *In re Newell*, 13 USPQ2d 1248 (Fed. Cir. 1989).

- **Obviousness: motive - art taken as whole**

As long as some motivation or suggestion to combine the references is provided by the prior art taken as a whole, as is the case here, the law does not require that the references be combined for the reasons contemplated by the inventor. *In re Beattie*, 974 F.2d 1309, 24 USPQ2d 1040 (Fed. Cir. 1992) and *In re Lintner*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972).

- **Obviousness: not abs. predictability**

Only a reasonable expectation of success, not absolute predictability, is necessary for a conclusion of obviousness. *Ex parte Beck*, 9 USPQ2d 2000 (BPAI 1988).

- **Omnibus claims violate 112 (2d para)**

Omnibus claims, e.g., "As a new article of manufacture, mats made of corn husks, substantially in the manner described," are properly rejected under 35 USC 112, 2d paragraph. *Ex parte Fressola*, 27 USPQ 1608 (BPAI -expanded panel- 1993).

- **On sale - sale not consummated**

A sale need not be consummated for an "on sale" bar to operate, and evidence that an offer for sale of a refrigerator hinge was made and signed with quantity and price established, prior to critical date, is clear and convincing evidence of an on-sale bar. There is no "joint development" exception to the on-sale bar, but a sale must be between two separate entities. *Bulkdex v. Kason*, 7 USPQ2d 1325 (CAFC 1988).

- **On Sale Bar - Experimental Use exception**

Installation of the claimed iris arm lamp support at a Wyoming rest area closed to the public during the test, whose drawings had a confidentiality Notice thereon, and Wyoming had a statute to preserve confidentiality, constitute an "experimental use" exception to the "on sale" bar of 35 USC 102(b). *Manville Sales v. Paramount Sys.*, 14 USPQ2d 1291 (DC, ED PA 1989), *aff'd* 16 USPQ2d 1587 (Fed. Cir 1990).

- **On sale bar - totality of circumstances**

Courts look to the "totality of circumstances" to decide if an invention was actually offered for sale. In this case, as of the critical date, there was an actual reduction to practice of a system and S's quotations were sufficiently concrete to place that system "on sale" for purposes of 35 USC 102(b). *Sonoscan Inc. v. Sonotek Inc.*, 17 USPQ2d 1247 (DC, ED VA 1990).

- **ON sale bar found: no red. to practice**

Another "on sale" bar found here despite no actual reduction to practice. No probative evidence introduced to show that the sale was for experimental purposes. Only evidence in this regard was merely conclusory affidavit by inventors that use was experimental. *Branahan Ind. Inc. v.*

Hydrafab Inc. 11 USPQ2d 1529 (DC SD TX 1989).

- **On sale bar: lack of control over tests**

An "on sale" bar was found here where the test focussed on by the court was whether the testing done on the claimed invention was under the control of the inventor in the course of its offer for sale. The court found that the motivation for the tests was not experimental. In re Hamilton, 11 USPQ2d 1890 (Fed. Cir. 1989).

- **Ordinary skill in art: six factors**

Court lists six factors to consider in determining level of one of ordinary skill in the art, i.e., one who is attempting to solve the problems the inventor addressed. In this case, the skilled worker in this art in 1984 was a design engineer with a mechanical engineering or equivalent college degree, with several years experience in this art. Moco Motion Inc v. Exac Corp. ,16 USPQ2d 1001 (DC ND Cal 1990)

- **Patent Term Restoration Act Time Limit**

Patent Term Restoration Act of 1984, 35 USC 156 requires an application filed with the PTO within the 60 day period beginning on the date the product received permission from the FDA, i.e, the date the FDA letter sent its approval letter to applicant, not when the DEA released it from Schedule I to Schedule II of the Controlled Substances Act. Unimed v. Quigg, 12 USPQQ 1644 (Fed Cir 1989).

- **Patentability burden shifted to applican**

Alternative rejection of product-by-process claim under 102(b) as anticipated by, or under 103 as obvious over, A or B is proper. Here, examiner shifted burden of proof to applicant through objective evidence to establish that the claimed products differ from the products of the references (PTO can't mfg. products and compare prior art products. but applicant can. Ex parte Jungfer, 18 USPQ2d 1796 (BPAI1991)

- **Patenting requires paying fees**

You cannot have a patent granted to you without payment of the fees prescribed for the filing, issuing, and maintaining a patent in force. Giuliani v. U.S., 8 USPQ2d 1095 (DC D HAWAII 1988).

- **Perlim. Motions movant - burden of proof**

Movant under 37 CFR 1.633(a) for judgment because claims lack written description support bears burden of proof which prima facie establishes that the limitation in question lacks either express or inherent support in the involved application. Mere attorney argument will not suffice. Behr v. Talbott, 27 USPQ2d 1401 (BPAI expanded panel on recon 1992)

- **perliminary mos. burden on challenger**

BPAI correctly decided that burden of proof is on moving party in preliminary motion under 37 CFR 1.633(g) challenging benefit of priority date. Kubota v. Shibuya, 27 USPQ 1419 (CAFC 1993)

- **Printed matter N/A re Data Proc. Systm**

Printed Matter cases deal with claims defining as the invention certain novel arrangements of printed lines or characters, useful and intelligible only to the human mind. In re Bernhart, 163 USPQ 611 (CCPA 1969). Printed matter cases have no factual relevance where invention is defined by claims requiring info be processed not by the mind but by a machine, the computer. In re Lowry 32 USPQ2d 1031 (CAFC 1994)SN 07/181,105.

- **Printed matter rej. takes another hit**

Printed Matter rejections take another hit. "The PTO may not disregard claim limitations comprised of printed matter." The CAFC does not give patentable weight to printed matter absent a new and unobvious functional relationship between the printed matter and its substrate. In re Edward S. Lowry, CAFC decision No. 93-1558, August 26, 1994 (SN 07/181,105). That new and unobvious funnc. rel. exists here.

- **Prior art must be enabling**

It is well settled that prior art under 35 USC 102(b) must sufficiently describe the claimed invention to have placed the public in possession of it, i.e., even if the claimed invention is disclosed in a printed publication, that disclosure will not suffice as prior art if it was not enabling. Ex parte Thompson, 24 USPQ 1618 (BPAI 1992).

- **Priority: elements, when diligence matters**

There are three issues relevant to the question of priority: conception, reductio to practice, and diligence. The party who is first to conceive and first to reduce to practice prevails. But, if the first to conceive the invention is not the first to reduce it to practice, the additional element of diligence comes into play. Allied signal Inc v. Allegheny Ludlum Corp., 18 USPQ2d 1080 (DC Conn 1990).

- **Pro se not denied due process by PTO**

Pro se applicant sought money damages from the PTO which had rejected all of his applications under 35 USC 112, and some of them on prior art, as well. He had filed petitions which had been denied, and made it difficult for the court to understand his arguments. Court found no denial of due process & granted the PTO's motion for summary judgment. Stagner v. PTO, 11 USPQ2d 1553 (DC, D KS 1989).

- **Product by process claims - 112, 4th exc**

Charlie Lovell's dissent in part states, without citation, that the only exception to the requirement of 35 USC 112, 4th paragraph is in regard to product by process claims. Ex parte Moelands, 3 USPQ2d 1474 (BPAI 1987).

- **Product-by-process claims**

Patentability of product-by-process claims is determined on the basis of the product formed and not on the method by which it is produced. Ex parte Jungfer, 18 USPQ2d 1796 (BPAI 1991). However, in determining infringement, product-by-process claims cover only the process of making the product, not the product. Tropix v. Lumigan Inc., 27 USPQ2d 1475 (DC Mass 1993).

- **Prosec. history estoppel: good example**

Prosecution history estoppel applied here to patentee who modified claim during prosecution to avoid prior art. Claim limited to "figure eight" configuration. Defendant had only "oval" configuration. No infringement. Environmental Instruments inc. v. Sutron Corp. 11 USPQ 1132 (Fed. Cir. 1989).

- **Protested reissue with court order**

In a protested reissue application with a court order allowing a third party to participate in all phases of the reissue proceedings before the Patent Office", the court order is NOT directed to the PTO, and the PTO will NOT permit the third party to present oral argument at the hearing-on-appeal. The Board may request written input from the third party, however, as an option. In re Blaese, 19 USPQ2d 1232 (Com. P&TM 1991)

- **Provisional 102(e)/103 rej's OK**

A provisional rejection under 35 USC 102(e)/103 based on a commonly owned, but different inventive entity application IAW MPEP 706.02 is proper. It cannot be overcome via a terminal disclaimer. Such rejections are distinct from double patenting rejections. Ex parte Barfield, 16 USPQ 1714 (BPAI 1990).

- **Provisional dbl. patenting rejections OK**

Provisional double-patenting rejection of claims in this application over claims in a related copending application which are also rejected in the copending case is entirely proper. Applicant is made aware of the possible existence of double patenting at an early date to permit him to elect which application to issue. It expedites prosecution. Ex parte Karol, 8 USPQ2d 1771 (BPAI 1988).

- **PTO Exr's: limits on compelled testimony**

Patent Examiners cannot be compelled in a Federal District Court proceeding to testify about their "mental processes" in reaching a decision on an application. Only factual matters, not reaching "the examiner's bases, reasons, mental processes, analyses or conclusions" are fair subjects for

inquiry. *Green v. Rich Iron Co. Inc.*, 20 USPQ2d 1075 (CAFC 1991).

- **Public Use - NMR Spectrometer**

The fact that one scientist told another of the invention in private but did not impose secrecy requirement does not argue against public use. Even if listener understood that article about invention was not to be published in the academic world, does not reflect confidentiality or secrecy. *National Research Development v. Varian Associates*, 28 USPQ2d 1436 (DC NJ 1993).

- **Public use - q. of law, sub. fact issues**

Whether something is "in public use or on sale" within the meaning of section 102(b), and thus properly considered prior art, is a question of law with subsidiary issues of fact, *In re Epstein*, 31 USPQ 1817, 1820 (CAFC 1994).

- **Publication: not here : confidentiality**

Communications between a patentee and a prospective manufacturer for development work is not a publication under 35 USC 192(b) due to a memo of agreement to confidentiality, and there was no distribution to others. *Southwest Aerospace Corp. v. Teledyne Industries Inc.*, 9 USPQ2d 1949 (DC NAla 1988).

- **Recapture doctrine in reissue: equitable**

"Error" within the meaning of 35 USC 251 does not include deliberate decision to surrender subject matter in order to overcome prior art; reissue claims for condom catheter are invalid under the recapture rule. *Mentor Corp. v. Coloplast, Inc.*, 27 USPQ2d 1521 (CAFC 1993).

- **Recapture in Reissue - avoided here**

Reissue applicant added a limitation to the reissue claims that was not found in original patent claims that were canceled in the patent prosecution, thereby avoiding the recapture rule. As stated in *Ball Corp v. U.S.*, 221 USPQ2d 289 (CAFC 1984), the patentee is free to acquire, thorough reissue, claims that are NARROWER in scope than the canceled claims. *Whittaker Corp. v. UNR Ind. Inc.*, 15 USPQ2d 1742 (Fed. Cir. 1990).

- **Reex: Duty of Candor to correct misrep.**

Patent owner, Requester, their attys & agents, in a PTO reexamination proceeding "have an uncompromising duty of candor" to the PTO. Duty applies when participant is or becomes aware of info material to PTO's det. of patentability. It includes an obligation to correct misrepresentations to the PTO as one becomes aware of them. *Ball Corp. v. Xidex Corp.*, 23 USPQ2d 1214 (CA, 10th Cir 1992),

- **reexam - use of affidavits, etc, OK**

Since rejection of a claim in reexamination is based on printed publications and patents, it is permissible to consider other "information" such as affidavits, declarations and transcripts to help define the scope and content of the prior art or to rebut a 35 USC 102 or 103 rejection. *In re Chambers*, 20 USPQ2d 1470 (Com'r Pat & TM 1991).

- **Reexam- interview std MPEP 713.01+**

In a reexamination proceeding interviews are conducted in accordance with MPEP secs. 713.01 - 713.04. The examiner did not abuse any discretion in denying an interview in this reexam because it was neither necessary or appropriate since the issues were clearly presented by the parties on the record. *In re Chambers*, 20 USPQ2d 1470 (Comr. Pat. & TM 1991).

- **Reexam- Mandamus against PTO denied**

Reexamination under prosecution when 2d reexam, which contained declaration explaining prior art by 3rd party Requester, was granted. Rejection over art was made and reliance made on the declaration. Court dismissed mandamus petition and APA act petition by patent owner. Court declared MPEP Section 2246 unlawful, however. *Allegheny Ludlum Inc v. Comer*, 24 USPQ2d 1771 (DC WD PA 1992)

- **Reexam- use admissions of any prior art**

In a reexamination proceeding, an examiner can use not only patents and printed publications, but, also, an ADMISSION relating to ANY prior art (i.e., on sale, public use, etc.) established in the record or in court. MPEP 2217, *Ex parte McGaughey*, 6 USPQ2d 1334 (BPAI 1988), *Quad*

Environmental Technologies v. Union Sanitary District, 20 USPQ2d 1392, 1395 fn.7 (CAFC 1991).

- **Reexam: Cannot broaden claims**

Amended or new claims in a reexamination proceeding must not enlarge the scope of the claims or any element thereof, *In re Ruth*, 126 USPQ 155, 37 CFR 1.552, and *Tillotson, Ltd., v. Wallbro Corp.*, 831 F.2d 1033, 1037 n.2, 4 USPQ2d 1450, 1453 (Fed. Cir. 1987).

- **Reexamination - effective date of patent**

The amended claims in the reexamination certificate to overcome a patent examiner's rejection are substantive, and the effective date of the new patent is the date of its reissue. Summary Judgment against patentee. *The Laitram Corp. v. NEC Corp.*, 17 USPQ2d 1407 (DC EDLa 1990).

- **Reexamination nature: mainly ex parte**

A reexamination proceeding in the PTO is NOT as adversarial as court litigation. A third party bringing a request for reexam. is heard only on whether or not a substantial new question of patentability exists justifying reexam. The reexam. PER SE of the claims is entirely EX PARTE. *E.I. Dupont de Nemours & Co. v. Cetus Corp.* 19 USPQ2d 1174 (DC,ND CAL 1990).

- **Refs. not relied on in Exr's. Ans.**

References cited in examiner's answer to "show the general state of the art" will not be considered in reviewing obviousness rejection since they are not relied upon in the rejection and constitute improper attempt at "back door" introduction. (refs. were not survey/ency. articles permitted under *In re Boon*, 169 USPQ 231 (CCPA 1971)). *Ex parte Raske*, 28 USPQ 1304 (BPAI 1993).

- **Regi. Pat Atty: No 5 year recency req.**

The five year recency requirement of 37 CFR 10.6(d) and (e) was abolished on November 4, 1988. In view of that, name of petitioner, who had been listed on the Attorneys & Agent's Roster as having INACTIVE status, but subsequently left Federal Service and was certified as a member of the Minnesota Bar, was ordered placed on Attys & Agent's Roster as attorney. *In re Teicher*, 14 USPQ2d 1573 (Comr. Pat & TM 1989).

- **Reissue - 2d reissue 112 rej. OK**

We hold that claims added during a reexamination proceeding and determined to be patentable therein nevertheless remain "[a]mended or new claims presented during a reexamination proceeding . . . [which] will be examined . . . for compliance with the requirements of 35 USC 112", as required by 37 CFR 1.552(b). *Ex parte Rodgers*, 27 USPQ 1738 (BPAI 1992). *Calvert, Pendegrass & Staab* dissent.

- **Reissue - No stay of decl. JJ action**

Stay of action seeking declaratory judgment action of patent invalidity is not warranted pending PTO's reexam of patent in suit, since re-examination is not likely to settle controversy concerning patent at any time on the near future. *American Ceramicraft Inc. v. Eisenbraun Reiss Inc.*, 28 USPQ2d 1241 (DC NJ 1993)

- **Reissue - unexpired term of patent only**

Commissioner has authority to reissue patents under 35 USC 251 to reissue patents only "for the unexpired part of the original patent. Statute is unambiguous and must be followed. 25 USPQ2d 2055 (CAFC 1992).

- **Reissue breadth lim's - recapture applic**

Broadened reissue claims in reissue applic. filed within 2 years of issue date of patent OK here despite cancellation of narrower claims. The non-material, broader aspects of Ball's reissue claims render them sufficiently narrower than the cancelled claims to avoid the effect of the recapture rule. *Ball Corp. v. United States*, 221 USPQ 289, 296 (CAFC 1984).

- **Reissue can't cor. failure to file div.**

Applicant who acquiesced in examiner's restriction requirement, canceled non-elected claim, and allowed patent to issue on remaining claims cannot later add non-elected claim to patent by reissue under 35 USC 251, regardless of propriety of examiner's underlying restriction

requirement. Failure to file a div. application isn't correctable by reissue under 35 USC 251. In re Watkin-son, 14 USPQ2d 1407 (CAFC 1990).

- **Reissue declaration - Bad - Unenforceabl**

The declaration in this case fails to make a showing in compliance with 37 CFR 1.175(a)(5) particularly specifying the errors that rendered the patent partly inoperative and how they arose. Alcon Laboratories Inc. v. Allergan Inc., 17 USPQ2d 1365 (DC NDTex 1990).

- **Reissue declaration - Proper**

Changes to specification supported by proper reissue oath/declaration. Refers to MPEP 608.01(o). Reissue oath satisfies 37 CFR 1.175(a)(5) particularity requirement. Quantum Corp. v. Tandon Corp. 18 USPQ2d 1597 (DC NDCal 1991).

- **Reissue declarations inequitable conduct**

Reissue declarations submitted by patent attorney contained assertions devised to meet what he thought would be accepted as reissuable error without checking with the persons who allegedly made the error. "Oversight" was alleged and then attorneys scrambled to fashion declarations of fact to support that conclusion. Court called it "studied ignorance" and inequitable conduct. HP v. B&L 8 USPQ2d 1177 (DC NDCAL 1988).

- **Reissue error not to include recapture**

"Error" within the meaning of 35 USC 251 does not include deliberate decision to surrender subject matter in order to overcome prior art; reissue claims for condom catheter are invalid under the recapture rule. Mentor Corp. v. Coloplast, Inc., 27 USPQ2d 1521 (CAFC 1993).

- **Reissue oath.-specify all claim differences**

A Reissue applicant must specify every difference between the original patent claims and the reissue claims, based on 37 CFR 1.175 as a whole. Here, appellant's reissue decl. addressed only the excesses of the "signal processor" and failed to address the remaining "excesses and insufficiencies," as required by section 1.175(a)(3). In re Constant, 3 USPQ2d 1479 (CAFC 1987).

- **Reissue protesters: only limited rights**

Like third party reexamination requesters, third parties protesting reissue applications under 37 CFR 1.291 have only limited rights to participate in PTO proceedings. These third party protesters are limited to the filing of protests. The DC, DC will not let third party protester have any review of the PTO reexam. proceeding. They have other remedies in court. Hitachi Metals, Ltd. v. Quigg, 20 USPQ2d 1920 (DC, DC 1991)

- **Reissue:: Recapture is equitable**

"Error" within the meaning of 35 USC 251 does not include deliberate decision to surrender subject matter in order to overcome prior art; reissue claims for condom catheter are invalid under the recapture rule. Mentor Corp. v. Coloplast, Inc., 27 USPQ2d 1521 (CAFC 1993).

- **Reissue oath: specificity required**

The errors in the claims must be particularly specified in the reissue oath or declaration. 37 CFR 1.175(a)(4) and (5). Alcon v. Allergan, 17 USPQ2d 1365, 1375 (DC, NDTex. 1990) and Hewlett-Packard v. Bausch & Lomb, 11 USPQ2d 1751 (CAFC 1989) as well as MPEP Section 1414.02 and 1414.03.

- **Rejections - legal standard**

Preponderance of the evidence is the standard that must be met by the PTO in making rejections. In re Epstein, 31 USPQ2d 1817, 1820 (CAFC 1994).

- **Rejections not continued are withdrawn**

All rejections previously made and not continued are considered as withdrawn. Because the final rejection didn't cite 35 USC 112, the PTO presumably withdrew the rejection. Since sufficiency of disclosure was not a basis of the final rejection, it could not have been appealed. Waldemar v. Osteonics. 31 USPQ2d 1855, 1857 (CAFC 1994).

- **Relevant prior art (game vs. real thing)**

The applicability of a reference as prior art is determined not whether it is directed to a game or

th "real world use", wut re whether the teachings of the reference place it within the field of the inventors' endeavor or, alternatively, within a field reasonably pertinent to the particular problem which the invention addresses. (Electr. brokerage game vs. real funds transfer)
In re Davis, 10 USPQ2d 1175 (CAFC 1989).

- **Res Judicata - no new evidence of record**

In sustaining the rejection of all claims under the doctrine of RES JUDICATA, we realize that it should not be applied where applicant has refiled after a 2d rejection to introduce new evidence favorable to granting patentability, EX PARTE SWANSON, 215 USPQ 564 (BA 1982) & IN RE OELRICH, 666 F.2D 578, 212 USPQ 323 (CCPA 1981). Here ,there is no new evidence submitted. (unpub, SN07/813,870, App. No.93-2337)

- **Return of unauth. papers, & belated req.**

Petition to Comr. of dismissal of belated req. for recon, of decision denying party's motion for additional discovery. Belated req. for recon, had two exhibits attached which were not presented to EIC and no explanation of the belatedness was enclosed. Petition denied and both exhibits returned to petitioner as improper papers under 37 CFR 1.618. Kellenberger v. Duenk, 18 USPQ2d 1574 (Comr. Pat. &TM 1991)

- **Rules of Evidence - applic. to USPTO**

General rule is that administrative agencies like the PTO are not bound by the rules of evidence. Agencies may provide for the application of the rules of evidence, as the PTO has in interference proceedings. Rule 1.671(b), and patent public use proceedings, Rule 1.292(a), and Trademark inter partes proceedings, but not in ex parte examination. In re Epstein, 31 USPQ2d 1817, 1821 (CAFC 1994).

- **Sec 256: what "error" doesn't encompass**

Inventorship change disapproved. The facts were known to the attorney when the case was filed. The patent has been issued for over six years. "Error" in naming or omitting joint inventors under 35 USC 256 does not encompass "gross negligence in avoidance of responsible knowledgeable parties having full notice of the facts and their significance. Consolidated Aluminum v. Foesco Int'l, 10 USPQ2d 1143 (DC ND IL 1988).

- **Spec. Testy re ineq. cond.:R.1225(b) OC**

Special testimony period concerning matters ancillary to priority by junior party under 37 CFR 1.225(b) O.C. requires a showing of good cause. Where inequitable conduct is alleged, a more rigorous standard is applied. BPAI refused to grant a testy period for this purpose. Asari v. Zilges, 8 USPQ2d 1117 9BPAI 1987).

- **Summary Judgment under 37 CFR 1.617**

Five additional declarations submitted in response (filed re 37 CFR 1.617(b)) to an Order to Show Cause issued under 37 CFR 1.617(a) were not considered. Even if party under OC's explanations that these affidavits weren't available initially are accepted (and they're not) ,that party could have filed a dec. on information & belief (1.608(b)). Summary Judgment issued. Surabian v. Brecher, 16 USPQ 1312 (BPAI 1990).

- **Synergism - re non-obv./not unpat.**

Synergism is probative of non-obviousness, but is not required for patentability. Ryko Mfg. Co. v. Nu-Star Inc. 21 USPQ2d 1053 (CAFC 1991).

- **Term. discl.: no good re 102(e)/103 rej.**

Claims rejected under 35 USC 102(e)/103 over references having earlier filing dates that applicant, different inventive entities and were commonly assigned. A terminal disclaimer cannot overcome such a rejection, although it could have overcome an obviousness double patenting rejection. In re bartfeld, 17 USPQ2d 1885 (Fed. Cir. 1991).

- **Terminal Discl - limited avail. & effect**

A terminal disclaimer is of circumscribed availability and effect. It is not an admission of obviousness of a later-filed CLAIMED invention in light of an earlier-filed DISCLOSURE. A rejection for obvious-type double patenting means the CLAIMS of a later-filed application are

deemed obvious from the CLAIMSA of an earlier patent. *Quad Env.Tech. v. Union Sanitary District*, 20 USPQ2d 1392 (FACF 1991).

- **Terminal disclaimer - deceptive/delay NA**

Filing of a terminal disclaimer under 35 USC 253 to overcome an obviousness-type double patenting rejection, a party need not concur with the now omitted, former requirements of filing it without deceptive intent and without delay. Both questions are irrelevant to the filing of a terminal disclaimer. *Bayer AG v. Barr Labs Inc*, 24 USPQ2d 1864 (DC SD NY 1992).

- **Terminal disclaimer - no estoppel**

In legal principle, the filing of a terminal disclaimer simply serves the statutory function of removing the rejection of double patenting, and raised neither presumption nor estoppel on the merits of the rejection. It merely obviates the rejection. *Quad Environmental Technologies v. Union Sanitary District*, 20 USPQ2d 1392 (CAFC 1991).

- **Test for adequate discl. for amend.claim**

When the scope of a claim has been changed by amendment, we must determine if the newly claimed subject matter was described in the original disclosure in a way to justify the manner in which it is not claimed. The terms "not permanently fixed" are adequately described in the original disclosure. *In re Wright*, 9 USPQ2d 1649 (Fed. Cir. 1989).

- **Undefined terms - use tech. dictionary**

Definition of terms not defined in the application - resort is had to a technical dictionary. In this case, respt was had to the IEEE Standard Computer Dictionary (1991) to define the term "data structure" as "a physical or logical relationship among data elements, designed to support specific data manipulation functions. *In re Warmerdam*, 31 USPQ2d 1754,1760 (CAFC 1994).

- **Unpub CAFC Decisions - be leery**

We stress that non-precedential, unpublished memorandum opinions of the CAFC are NOT to be taken as the CAFC's adoption of a district court's reasoning. Affirmance by the CAFC could have been on any ground appropriate to the case. *Quad Environmental Technologies v. Union Sanitary District*, 20 USPQ2d 1392 (CAFC 1991).

- **Unpub. Dec.-Req. to Publish**

CAFC denies request to publish unpub decision. Requester seeks publication to preclude BPAI from expanding previous CAFC decision in a design patent case. *In re Butera*, 28 USPQ2d 1399 (CAFC, unpub. 1993).

- **Unsigned Oath: no abnd, no 1.53(d)Notice**

Patent application was filed with a declaration unsigned by the applicant. Since PTO failed to notify applicant under 37 CFR 1.53(d) of this fact and did not give him a period of time in which to correct it, the application (subsequently, expressly abandoned for a continuation) did not go abandoned. *In re Rosenberg*, 15 USPQ2d 1751 (Comr Pat & TM 1990).

- **Utility Pat denied benefit of Design Pat**

Drawings contained in patentee's design patent for dual-lumen hemodialysis catheter are not "written description" of invention to satisfy 35 USC 112, since the drawings cannot show which of invention's attributes are "features" of the invention, and how much variation in what is shown is allowable. *Vas-Cath Inc. v. Mahurkar*, DC ND Ill 1990).

- **Words & Phrase - generating a plasma**

Phrase "generating a plasma around the item" in claims for a method patent which uses plasma to sterilize surgical instruments and medical devices, requires item to be within electromagnetic field which produces the plasma. *Advanced Sterilization Products v. Ablox Inc*, DC NCalif(1993), 30 USPQ2d 1161.

- **Words & Phrases - "Connector means"**

Thers "connector means" in computer interface art are not broad enough to cover any device that electrically connects computer or peripheral devices since 35 USC 112, para 6 limits literal scope of means plus function limitation. Only disclosed connector means are male and female type plugs. "mouse" does not infringe. *Microsoft Corp. v. IQ Technologies Inc.*, 28 USPQ2d 1477

(CAFC 1993).

- **Words & Phrases - bidirectionally movab**

Conflicting interpretation of the terms "bidirectionally moveable electro-mechanical mover" require expert testimony to resolve. A genuine issue of material fact exists here. Quantum Corp. v. Tandon Corp. 18 USPQ2d 1607 (DC NDCal 1991).

- **Words & Phrases - defn of "p-code"**

P-code is shorthand for "pseudo-code," which is defined in RANDOM HOUSE DICTIONARY OF THE ENGLISH LANGUAGE (1987) as a "program, code unrelated to the hardware of a particular computer and requiring conversion to the code used by the computer before the computer can be used. Ex parte Logan, 20 USPQ2d 1465 (BPAI 1991).

- **Words & Phrases - integral**

Prosecution history, in which patentee overcame specific prior art rejections by adopting position that its catheter was an improvement over prior art because its central tube and balloon formed a single piece of material without glue or adhesives, limits meaning of "integral" so that claims do not cover accused two-piece catheter. Advanced Cardiovascular Systems v. CR Bard, 26 USPQ2d 1304 (DC NDCal 1992).

- **words & Phrases - One-piece vs. integral**

Proper definition of "one-piece" is, in view of drawings, its most literal and narrow, meaning unit made from a single, homogenous material. The term "integral" means something different from "one-piece," and includes both homogenous and separate but joined elements, and broadest meaning of "integral" includes components separate initially, but later joined together. In re Miskinyar, 28 USPQ2d 1789 (CAFC 1993)

- **Words & Phrases - removably connecting**

Terms "removably connecting" in claim are definite to one of ordinary skill in the art. Dist. Ct. improperly read weight limitations in spec. into preamble of claims to improperly limit claim scope. Preamble appears to be only a statement of purpose and use here. "Comprising" and "including" are normally open ended terms. Prosecution history does not teach otherwise. Burke Inc. v. Everest & Jennings, 29 USPQ2d 1393 (CAFC 1993).

- **Words & Phrases - Removably mountable**

Ordinary meaning of "removably mountable," in claims for kit with minilights that can be attached to garments, does not encompass minilights attached permanently, such as with glue. American Ceramicraft v. Eisenbraun Reiss Inc., 28 USPQ2d 1241 (DC NJ 1993).

- **words & phrases - substantially**

The word "substantially" encompasses a relatively wide range of values. See, for example, In re Sinex, 135 USPQ 302 (CCPA 1962), where a substantially horizontal surface was claimed and was deemed met by a reference whose surface was at nine(9) degrees from the horizontal.

- **Words & Phrases: "computer" = calculator**

The term "computer" lacks any standard definition but is commonly understood by skilled workers to encompass, at its most fundamental level, a device that is capable of carrying out calculations, and thus prior art reference that discloses a calculator meets all claim limitations for a portable computer. No more limiting definition in application disclosure. In re Paulsen, 31 USPQ2d 1671 (CAFC 1994).

- **Words & Phrases: Adjacent; Converge**

Term "adjacent" does not necessarily mean "separate and independent" and term "converge" does not necessarily mean converge at a specific object, but may mean convergence before reaching that object (a tooth). Electro Medical Systems v. Cooper Life Sciences, 32 USPQ2d 1017 (CAFC 1994).

- **Words & Phrases: Being**

The issue here is whether the claim term "being" means "comprising", a term that covers steps, elements or materials in addition to those the claim specifies; or means "consisting of" or "consisting essentially of", terms that limit the claims to the recited steps. The record supports the

latter - more like "consisting of" or "consisting essential -ly of." *Sonoco Products v. Mobil Oil Corp.*, 15 USPQ2d 1194 (Fed. Cir. 1990).

- **Words & Phrases: "about 1.27 cm"**

Claim was directed to a tie lug - a casting used to anchor water pipes at an elbow joint to create a seal under pressure - that recites a body "having a thickness of ABOUT 1.27 cm". The use of "ABOUT" did not overcome the precise construction of the patentee's use of a numeral taken to two decimal places" so as to bring defendant's lugs within its literal scope. *Astral v. Metcalfe*, 17 USPQ2d 1870 (unpub. CAFC decision 1990).

- **Words & Phrases: "at least about" no good**

Because the term "about 160,000 IU/A" gives no hint as to which mean value between the prior art value of 128,620 and the mean specific activity level of 160,000 constitutes infringement, court holding of claim invalidity was proper. "About" may be acceptable in appropriate fact situations, however. *Jurgens v. McKasy*, 18 USPQ2d 1016 (CAFC 1991).

- **Words & Phrases: "uniformly irradiated"**

The claim terminology "uniformly irradiated" was construed as meaning "more consistent exposure" of object to radiation as contrasted with the "uneven radiation" provided by the prior art. The court correctly determined that the claim language does not require absolute uniformity. *Shamrock Technologies Inc. v. Medical Sterilization Inc.*, 14 USPQ2d 1728 (Fed. Cir. 1990).

- **Words & Phrease - "relatively shallow"**

Terms "relatively shallow" in claim, where specification does not further define them, render the claims vague and indefinite and they violate 35 USC 112, 2d para. In cases like this, non-chemical cases, the words in a claim are generally not limited in their meaning to what is shown in the disclosure. *Ex parte Oetiker*, 23 USPQ2d 1651 (BPAI 1992). *In re Oetiker*, 23 USPQ2d 1661 (CAFC 1991).

- **Words in claims - "about"**

The term "about" used in relation to temperatures included temperatures a few degrees above and a few degrees below the specified temperature. *Ex parte Shelton*, 92 USPQ 374 (Bd. Pat. Int. 1950).

- **Written Description - Drawings OK as**

Drawings alone may provide "written description" of invention as required by 35 USC 112, and may be used, like written specification, to provide evidence relevant to claim interpretation, and thus claims, in proceeding before USPTO, must be given their broadest reasonable interpretation consistent with drawings as well as specification. *In re Miskinyar*, 28 USPQ2d 1789 (CAFC 1993).

- **Written Description - genus/subgenus**

Disclosure of genus and subgenus within that genus is not sufficient description of subgenus to satisfy 35 USC 112 unless there are specific facts that lead to conclusion that the subgenus is implicitly described. *Ex parte Westphal*, 26 USPQ2d 1858 (BPAI 1993).

- **Written description components - Int.**

Written description requirement is broader than to merely explain hoe to "make and use." The applicant must also convey with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession OF THE INVENTION. The invention is, for purposes of the written description inquiry, WHATEVER IS NOW CLAIMED. *Staehelin v. Secher*, 24 USPQ2d 1513, 1520 (1992)

- **Written description met by drawings**

Claim limitations regarding a "channel" are supported by figures 1 and 2 which clearly illustrate a "channel." It is well established that the invention claimed need not be disclosed IPSIS VERBIS to satisfy the disclosure requirements of 35 USC 112, citing *In re Likach*, 169 USPQ 795 (CCPA 1971), *Ex parte Holt*, 19 USPQ2d 1211 (BPAI 1991).